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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,036

03/19/2004

Kia Silverbrook

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

HO, TUAN V

ART UNIT

PAPER NUMBER

2622

MAIL DATE

DELIVERY MODE

01/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/804,036

Applicant(s)

SILVERBROOK, KIA

Examiner

Tuan V. Ho

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/113,086.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 are 6-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 7,119,836. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

With regard to claim 1, claim 1 is an obvious variant and encompassed by claim 1 of the patent'836. It should be noted

that claimed image sensor and processor are inherently included in the camera imaging system of claim 1 of Patent'836,

With regard to claim 6, claimed address zone is met by "printed information includes countries" of claim 4 of Patent'836

With regard to claim 7, claimed blank zone is inherently included in the formatted postcard information of claim 1 of Patent'836 since the blank space is filled out by an address.

With regard to claim 8, claimed memory is met by memory of claim 1 of Patent'836.

3. Claims 1 and 6-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent No.6,831,681. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

With regard to claim 1, claim 1 is an obvious variant and encompassed by claim 1 of the patent'681. It should be noted that claimed image sensor and processor are inherently included in the camera imaging system of claim 1 of Patent'681.

With regard to claim 6, claimed address zone is met by "printed information includes countries" of claim 2 of Patent'681

With regard to claim 7, claimed blank zone is inherently included in the formatted postcard information of claim 1 of Patent'681 since the blank space is filled out by an address.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 5,847,836) in view of Barber (US 5,343,386).

With regard to claim 1, Suzuki discloses in Fig. 1, a printer built-in video camera that comprises print generator (printer engine 52, col. 6, line 35-36) comprising an image sensor device for capturing an image (CCD 40, col. 5, line 55) and an image processor for processing a captured image (image processor, col. 6, lines 20-62); and a pagewidth printhead

configured to print a captured (ink-jet head 5, col. 6, line 4; it should be noted that the head 5 can print the whole page width) and the processed image on a first side of a print media (printer 52 can print an image on one side as shown in Fig. 1), except for to print a postcard format onto a second side of said print media.

Suzuki does not explicitly disclose any a postcard format onto a second side of said print media. However, Barber teaches using printing sheets of paper in a video postcard system, that include a plurality of formatted postcard information including pre-printed postage, address and message on the opposite side of the image side for immediate mailing (col. 2, line 20 and col. 3, lines 3-12). It is noted that postcard information preprinted in the back surface of a printed paper correspond to an object image that is selected by a user so as to be immediately mailed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the print roll of Suzuki in the same fashion as disclosed by Barber so as to obtain a plurality of formatted postcard information pre-printed on the back surface of the print roll for immediate mailing after printing and thereby conveniently to mail an post

card without going to a post office for a postage and thereby to improve the camera versatility.

With regard to claims 2 and 3, Furthermore, Barber discloses a token indicating that postage has been paid, said token being printed onto said print media by said printhead (Barber discloses in col. 2, lines 19+ that postage is for immediately mailing; as a result, a token is inherently printed on the postcard so as to mail).

With regard to claim 4, Furthermore, Barber discloses tokens pre-marked indicating that postages are paid for immediately mailing (col. 2, lines 19+).

With regard to claim 5, tokens are printed are pre-printed at regularly spaced intervals the surface of the print media adapted to receive the postcard format thereon, the spacing being substantially equal to the size of the printed image to be printed on the other side of the print media (the postcard information is inherently pre-printed in a predetermined interval on the back surface of the print roll; where the postcard information corresponds to an object image selected to be printed on the front surface of the print roll. Otherwise, a user cannot mail the post card because of missing the postcard information).

With regard to claim 6, Barber discloses the postcard format includes an address zone (An address zone is inherently included in the postcard; where the address zone is used to show an address of a receiver).

With regard to claim 7, Barber discloses the postcard format includes a blank zone (a blank zone inherently included in the postcard since it used to hold an address).

With regard to claim 8, Suzuki in view of Barber does not disclose any memory for storing the postcard format.

Official Notice is taken for a memory is used to hold a postcard format so as to provide different printed postcards.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the memory 56 of Suzuki so as to store postcard formats because the storage of postcard formats would allow a user to print different postcards at different scenes and thereby to improve camera efficiency.

With regard to claim 9, Suzuki discloses the guillotine adapted to separate a printed postcard from the print roll (cutter 42, col. 8, line 10).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan Ho whose telephone number is (571) 272-7365. The examiner can normally be reached on Mon-Fri 7:00AM-4:00PM.

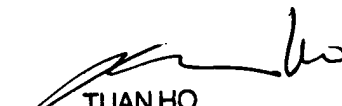
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



TUAN HO
PRIMARY EXAMINER